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UNITED STATES DEPARTMENT OF COMMERCE
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Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Peter Miller
39 Sidney Grove
Newcastle, Great Britain
NE4 5PD

In re Application of :
MILLER : DECISION
Application No.: 09/242,072 :
PCT No.: PCT/AU96/00442 :
Int. Filing Date: 05 August 1996 :
Priority Date: None :
Atty Docket No: None :
For: APPARATUS FOR LIQUID PURIFICATION :

This decision is in response to applicant's petition filed 20 December 1999 requesting that the "Notification of A Defective Response" (Form PCT/DO/EO/916) and "Notification of a Defective Oath or Declaration" (Form PCT/DO/EO/917), mailed 03 November 1999, be vacated, and "the return of the application to pending status awaiting examiner action after the applicant's response 07 SEP 99."¹

BACKGROUND

On 05 August 1996, applicant filed international application no. PCT/AU96/00442, which designated, *inter alia*, the U.S. A Demand electing, *inter alia*, the U.S. was filed within 19 months of the international filing date. Accordingly, the deadline for entering the U.S. national stage expired 05 February 1999.

On 01 February 1999, applicant filed a transmittal letter (Form PTO-1390) requesting entry into the U.S. national stage accompanied by: 1) payment of \$990.00 (allocated as \$360.00 for the basic national fee and \$135.00 for the multiple dependent claim fee), 2) an oath, and 3) a small entity statement.

On 17 June 1999, a "Notification of Missing Requirements" (Form PCT/DO/EO/905) and "Notification of Defective Oath or Declaration" (Form PCT/DO/EO/917) were mailed to applicant indicating that the oath failed to comply with 37 CFR 1.497(a)-(b) as it did not

¹ Though Form PCT/DO/EO/917 bears an 06 October 1999 mail date, it is clear that such is a typographical error, as Form PCT/DO/EO/916 indicates that Form 917 is an attachment. Further, the present petition states that both forms were received in the same envelope.

identify the citizenship of the inventor. A new oath or declaration in compliance with 37 CFR 1.497 and surcharge fee under 37 CFR 1.492(e) were required.

On 06 July 1999 applicant filed a new oath and surcharge fee.

On 30 August 1999, a "Notification of Defective Response" (Form PCT/DO/EO/916) and "Notification of Defective Oath or Declaration" (Form PCT/DO/EO/917) were mailed to applicant indicating that the oath failed to comply with 37 CFR 1.497(a)-(b) as it did not identify the specification to which it is directed.

On 15 September 1999, applicant filed a third oath.

On 03 November 1999, a "Notification of Defective Response" (Form PCT/DO/EO/916) and "Notification of Defective Oath or Declaration" (Form PCT/DO/EO/917) were again mailed to applicant indicating that the oath failed to comply with 37 CFR 1.497(a)-(b) as it was not executed in accordance with 37 CFR 1.66 or 1.68 and it did not identify the citizenship of the inventor.

On 20 December 1999, applicant filed the present petition requesting that the "Notification of A Defective Response" (Form PCT/DO/EO/916) and "Notification of a Defective Oath or Declaration" (Form PCT/DO/EO/917) mailed 03 November 1999 be vacated and "the return of the application to pending status awaiting examiner action after the applicant's response 07 SEP 99."

DISCUSSION

I. Fees

It is first noted that applicant's payment of \$990.00 to cover the basic national fee and multiple dependent claim fee is insufficient. Specifically, the basic national fee then required was \$485.00 for a small entity. The amount of \$360.00 indicated in applicant's Fee Sheet was not then current, nor was applicant entitled to pay a reduced fee in the case where the international preliminary examination was conducted by the U.S. (the Australian Patent Office was the international preliminary examining authority for the international application).

To avoid abandonment of the application for failure to pay the full basic national fee by the 05 February 1999 deadline, the money indicated for the multiple dependent claim fee has been allocated toward the basic national fee. Accordingly, there currently exists a \$120.00 fee deficiency in the required multiple claim fee (i.e., \$130.00 (required fee) - \$10.00 (actual payment)).

II. Vacating Forms PCT/DO/EO/916 and 917

The "Notification of Defective Response" (Form PCT/DO/EO/916) and "Notification of Defective Oath or Declaration" (Form PCT/DO/EO/917) mailed 03 November 1999 indicate that the oath fails to comply with 37 CFR 1.497(a)-(b) as it was not executed in accordance with 37 CFR 1.66 or 1.68 and it did not identify the citizenship of the inventor.

Applicant requests that these forms be vacated. However, these forms correctly identify defects in the oath filed 15 September 1999, and accordingly, there exists no basis for vacating these forms.²

The present petition states that the PTO envelope containing the Forms 916 and 917 was not mailed until 06 December 1999, due to insufficient postage, and was not received by applicant until 16 December 1999. Attached to the petition is copy of the PTO mailing envelope supporting applicant's assertion.

While late receipt of an Office action may be grounds to have the **period for reply** set therein **restarted**, it is **not** grounds for having the Office action **vacated**. See MPEP 710.06, which states:

In the event that correspondence from the Office is received late (A) due to delays in the U.S. Postal Service, or (B) because the mail was delayed in leaving the PTO (the postmark date is later than the mail date printed on the correspondence), applicants may petition to reset the period for reply, which petition shall be evaluated according to the guidelines which follow. Where the PTO action involved in the petition was mailed by an examining group, the authority to decide such petitions has been delegated to the Group Director. See Notice entitled "Petition to reset a period for response due to late receipt of a PTO action," 1160 O.G. 14 (March 1, 1994).

Petitioner has not requested that the period for reply set in the "Notification of Defective Response," (i.e., one month from the 03 November 1999 mail date) be restarted. Nor would such request provide relief to petitioner in the present instance. PTO guidelines provide for restarting of the period for reply to begin on the **date of receipt** (where the delay was caused by the U.S. Postal Service) or the from **post office date indicated on the**

² It is clear from the record that applicant is having trouble complying with the technical requirements for an "oath." The requirements for an "oath," particularly where executed in a country outside the U.S., are complex. It is for this reason that a blank "declaration" was forwarded to applicant with the 30 August 1999 "Notification of Defective Response" for applicant to complete. A declaration is relatively easy to complete (a notary is not required) and may be substituted in lieu of an oath.

envelope containing of the Office action (where the PTO delayed in mailing the envelope). As indicated in the petition, the date of receipt is **16 December 1999**, and the post office date indicated on the envelope is **06 December 1999**. Accordingly, had petitioner requested that the period for reply be restarted, any grant thereon would, at best, only extend the period for reply until 16 January 2000. Applicant has not filed the required reply to the "Notification of Defective Response" as of that date. Accordingly, the application is abandoned.

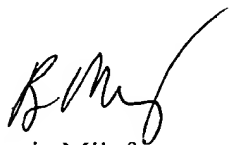
CONCLUSION

For the above reasons, the petition to vacate the "Notification of A Defective Response" (Form PCT/DO/EO/916) and "Notification of a Defective Oath or Declaration" (Form PCT/DO/EO/917) mailed 03 November 1999 is **DISMISSED**, without prejudice.

The present application is hereby held to be **ABANDONED**.

Applicant may wish to consider filing a petition under 37 CFR 1.137(b) to revive the present application based on unintentional abandonment. Any such petition must be accompanied by the petition fee of \$605.00 (small entity) as well as the required reply, i.e., an oath or declaration in compliance with 37 CFR 1.497(a)-(b). For applicant's convenience, forms for this purpose are enclosed herewith.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Boris Milef
Legal Examiner
PCT Legal Office

Telephone: (703) 308-3659

Facsimile: (703) 308-6459

Enclosures:

- blank petition under 37 CFR 1.137(b)
- blank declaration